



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,131	04/19/2000	Anuradha Narasimhaswamy Melkote	199-1997	3473

28549 7590 01/15/2003

KEVIN G. MIERZWA
ARTZ & ARTZ, P.C.
28333 TELEGRAPH ROAD, SUITE 250
SOUTHFIELD, MI 48034

EXAMINER

LY, ANH

ART UNIT PAPER NUMBER

2172

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

16

Office Action Summary

Application No.

09/552,131

Applicant(s)

MELKOTE ET AL.

Examiner

Anh Ly

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/28/2002 have been fully considered but they are not persuasive.

Watanabe et al. (USN: 6,157,947) discloses a distribution of intellectual property system through the Internet and intranets or web-based system (col. 1, lines 10-14; also see fig. 3 and col. 5, lines 20-54) from which the users enable to retrieve information as well as user information such as user name, a manager name and a group name (col. 6, lines 42-49 and see fig. 6). So, Watanabe discloses retrieval and updating intellectual property system, invention disclosure system, that users enable to access via Internet server of the web-based system. Watanabe discloses disclosure extents: each piece or portion of intellectual property may be inputted or registered with a disclosure extent so that the users can view it (col. 2, lines 10-18). Watanabe discloses category information (table 8-10, col. 13, lines 1-67 and col. 14, lines 1-65). Also Watanabe discloses IP information in the IP database and the users enable to transfer it to the request server (client site) (col. 7, lines 36-67).

Applicants' argued that (1) "no real detail is given in the Watanabe system as to how the information is provided to the system." (page 3, the last paragraph).

Response (1): Watanabe et al. of 6,157,947 (herein Watanabe) discloses a distribution system is used to distribute intellectual property and in which has a processing portion for providing a user with a service for the user and a communication portion for automatically distributing the intellectual property (see fig. 3, col. 5, lines 20-54; also see col. 1, lines 38-53, col. 2, lines 40-67 and see abstract). The information or each piece of intellectual property is inputted into memory portion by the users based on the category information (col. 2, lines 18-38).

Applicants' argued that (2) "can find no teaching or suggestion for a user entering identification information to retrieve user information based on the identification information to create at least a portion of the invention disclosure."

Response (2): Watanabe discloses IP users can retrieve IP information as well as user information in the server such as a manager name, user name and a group name via the CORBA server (col. 6, lines 8-55 and see fig 4; also see col. 11, lines 20-25 and col. 15, lines 27-38).

Applicants' argued (3) that, "No teaching or suggestion is provided in the Schneider reference for forming an invention disclosure in an on-line-type system." (page 4, the 3rd paragraph).

Response (3): Schneider of 5,987,464 teaches the user or subscriber can connect to the Internet or other on-line services via transceiver of computer system to

view a selected document and send back to the provider (see figs 4 and 11: col. 6, lines 8-25; also see col. 10, lines 30-40).

Thus, the arguments of applicant are not persuasive based on the prior art of record.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 7, 9, 17-18, 21-22, 37-38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,157,947 issued to Watanabe et al. (herein Watanabe).

With respect to claim 1, Watanabe discloses forming an invention disclosure online by entering a plurality of selected information portions into a web-based system; after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location; and allowing access to various users for reviewing the information (abstract, disclosure extents and piece of intellectual property and memory portion: col. 1, lines 8-14 and lines 38-67 and col. 2, lines 10-38; also see Internet or web-based system; col. 3, lines 20-54; col. 15, lines 24-58 and figs. 15 and 16).

Watanabe does not clearly disclose "an invention disclosure online, storing the information in a central storage location and allowing access to various users." But, however, Watanabe shows intellectual property is registered with a disclosure and the registered information is stored on memory on the web server system and users can be access to it and display or review it (see abstract, figs 4 and 5, col. 1, lines 38-67, col. 2, lines 1-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Watanabe such as intellectual property disclosure, memory, firewall, and web server so as to obtain a method of forming and displaying and accessing the invention disclosure via Internet in the legal practical services environment.

With respect to claims 2-3, Watanabe discloses step of forming includes providing identification information; whereby upon providing identification information to said web-based server; and retrieving user information from the directory system in response to the identification information (Internet, firewall: see figs 3 and 5, col. 20-54; user ID and password: col. 18, lines 35-61); and step of prompting the user for classification information (category information interpreting as classification information: see table 8-10 and col. 13, lines 1-67 and col. 14, lines 1-65; also see Intellectual Property (IP) ID: col. 11, lines 20-67 and col. 12, lines 1-67).

With respect to claims 7 and 9, Watanabe discloses ranking the disclosure; and prompting a patentability review from the patent staff person (col. 11, lines 20-67 and col. 12, lines 1-67; and col. 2, lines 1-39).

Claim 17 is essentially the same as claim 1 except that it is directed to a system rather than a method (abstract, disclosure extents and piece of intellectual property and memory portion: col. 1, lines 8-14 and lines 38-67 and col. 2, lines 10-38; also see Internet or web-based system; col. 3, lines 20-54; col. 15, lines 24-58 and figs. 15 and 16), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 18 is essentially the same as claim 2 except that it is directed to a system rather than a method (user ID and password: col. 18, lines 35-61), and is rejected for the same reason as applied to the claim 2 hereinabove.

With respect to claims 22-21, Watanabe discloses user computer comprises a CAD file viewer (col. 10, lines 10-40 and col.12, lines 30-60); and wherein said server comprises a web single login (col. 18, lines 35-61).

With respect to claim 37, Watanabe disclose entering identification information retrieving user information from a directory system in response to said identification information entering disclosure information to create an invention disclosure; coupling said user information with said disclosure; and storing the disclosure in a database (see abstract, col. 1, lines 8-14 and lines 38-67, col. 2, lines 1-39; IP database: see fig. 10 item 22 and 32 the portion of IP information is stored in the IP database in order to transfer to the request server , col. 7, lines 38-56).

Watanabe does not clearly disclose “an invention disclosure online, storing the information in a central storage location and allowing access to various users.” But, however, Watanabe shows intellectual property is registered with a disclosure and the registered information in stored on memory on the web server system and users can be access to it and display or review it (see abstract, figs 4 and 5, col. 1, lines 38-67, col. 2, lines 1-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Watanabe such as intellectual property disclosure, memory, firewall, and web server so as to obtain a method of forming and displaying and accessing the invention disclosure via Internet in the legal practical services environment.

With respect to claim 38 and 41, Watanabe discloses prompting the user for classification information; and prompting a patentability review from the patent staff person (col. 11, lines 20-67 and col. 12, lines 1-67; col. 12, lines 1-67; and col. 2, lines 1-39).

5. Claims 4-6, 8, 10-15, 19-20, 23-35, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,157,947 issued to Watanabe et al. (herein Watanabe) in view of US Patent No. 5,987,464 issued to Schneider.

With respect to claims 4-6 and 8, Watanabe discloses a method of forming an on-line invention disclosure as discussed in claim 1.

Watanabe does not explicitly indicate, "notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator; generating an E-mail; providing a hyperlink to the disclosure in the E-mail; notifying a patent staff person in response to the classification information; prompting an evaluation comprises scheduling an evaluation meeting."

However, Schneider discloses notifying to the user via e-mail, and hyperlink, and scheduler as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claims 10-15, Watanabe discloses a method of forming an on-line invention disclosure as discussed in claim 1. Also Watanabe discloses displaying and user ID and password as claimed (col. 2, lines 1-39 and col. 18, lines 35-61).

Watanabe does not explicitly indicate, "a database coupled to a web server; identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system; notifying comprises the step of generating an E-mail having a hyperlink therein; providing a status update via E-mail."

However, Schneider discloses database connecting with web server, notifying to the user via e-mail, hyperlink as claimed (see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claims 19-20, Watanabe discloses a system of forming an on-line invention disclosure as discussed in claim 17.

Watanabe does not explicitly indicate, "wherein said server comprises a web server and a web browser."

However, Schneider discloses web server and web browser as claimed (see fig. 11, col. 15, lines 52-67 and col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 23, Watanabe discloses forming an invention disclosure online by entering a plurality of selected information into a web-based system; after each of the plurality of selected information is entered, storing each of the plurality of selected information in a central storage location; allowing access to various users to access the information; prompting the user for classification information (abstract, disclosure extents and piece of intellectual property and memory portion: col. 1, lines 8-14 and lines 38-67 and col. 2, lines 10-38; also see Internet or web-based system; col. 3, lines 20-54; col. 15, lines 24-58 and figs. 15 and 16; category information interpreting as classification information: see table 8-10 and col. 13, lines 1-67 and col. 14, lines 1-65; also see Intellectual Property (IP) ID: col. 11, lines 20-67 and col. 12, lines 1-67).

Watanabe does not explicitly indicate, "notifying an evaluator; and prompting an evaluation from the evaluator."

However, Schneider discloses notifying and evaluating as claimed (col. 18, lines 40-67 and col. 19, lines 1-9 and lines 50-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the

teachings of Schneider so as to have an system of invention disclosure submission because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 24, Watanabe discloses forming includes providing identification information; whereby upon providing identification information to said web-based server, retrieving user information from the directory system in response to the identification information (col. 18, lines 35-61; col. 11, lines 20-67 and col. 12, lines 1-67).

With respect to claims 25-29, Watanabe discloses a system of invention discloses submission as discussed in claim 23. And Watanabe discloses ranking and displaying for review (col. 11, lines 20-67 and col. 12, lines 1-67; and col. 2, lines 1-39).

Watanabe does not explicitly indicate, "notifying an evaluator comprises the step of generating an E-mail; providing a hyperlink to the disclosure in the E-mail; prompting an evaluation comprises scheduling an evaluation meeting; and prompting an evaluation comprises ranking the disclosure."

However, Schneider discloses notifying to the user via e-mail, and hyperlink, and scheduler as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the

teachings of Schneider so as to obtain an invention disclosure submission system because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 30-35, Watanabe discloses a submission invention disclosure system as discussed in claim 23. Also Watanabe discloses displaying and user ID and password as claimed (col. 2, lines 1-39 and col. 18, lines 35-61).

Watanabe does not explicitly indicate, "central location comprises a database coupled to a web server; identifying co-authors; notifying co-authors of a disclosure with their name associated therewith in the system; notifying comprises the step of generating an E-mail having a hyperlink therein; viewing the status of the invention disclosure on-line; providing a status update via E-mail."

However, Schneider discloses database connecting with web server, notifying to the user via e-mail, hyperlink as claimed (see fig. 11, col. 3, lines 59-67, col. 4, lines 1-8, col. 10, lines 12-49, col. 15, lines 52-67, col. 16, lines 1-33).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 39-40, Watanabe discloses a method of submitting documents as discussed in claim 37.

Watanabe does not explicitly indicate, "notifying an evaluator in response to the classification information; prompting an evaluation from the evaluator; and notifying a patent staff person in response to the classification information."

However, Schneider discloses notifying an evaluator and notifying to a patent staff as claimed (col. 1, lines 15-26, col. 4, lines 62-67, col. 5, lines 1-9, col. 6, lines 8-25, col. 7, lines 26-45, col. 10, lines 12-49 and col. 12, lines 1-33; col. 18, lines 40-67 and col. 19, lines 1-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Schneider so as to obtain a method of submitting documents because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

6. Claims 16 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,157,947 issued to Watanabe et al. (herein Watanabe) in view of US Patent No. 5,329,447 issued to Leedom, Jr. (herein Leedom).

With respect to claim 16, Watanabe discloses a method of forming an on-line invention disclosure as discussed in claim 1.

Watanabe does not explicitly indicate, "accepting a paper submission; and wherein the step of forming comprises scanning said paper submission into the database."

However, Leedom discloses paper associated with law case and scanning system as claimed (col. 4, lines 52-67, col. 5, lines 1-12, col. 10, lines 8-34 and col. 15, lines 21-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the teachings of Leedom so as to obtain a method of forming an on-line invention disclosure because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

With respect to claim 36, Watanabe discloses an invention disclosure submission system as discussed in claim 23.

Watanabe does not explicitly indicate, "accepting a paper submission; and wherein the step of forming comprises scanning said paper submission into the database."

However, Leedom discloses paper associated with law case and scanning system as claimed (col. 4, lines 52-67, col. 5, lines 1-12, col. 10, lines 8-34 and col. 15, lines 21-56).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Watanabe with the

Art Unit: 2172

teachings of Leedom so as to have a system of invention disclosure submission because the combination would have a method for various users to access, the intellectual property disclosure information and to allow user to review it via Internet in the legal practical services environment.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

8. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527 or via E-Mail: **ANH.LY@USPTO.GOV**. The examiner can be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Kim Vu, can be reached on (703) 305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to: (703) 746-7238 (after Final Communication)


or: (703) 746-7239 (for formal communications intended for entry)

or: (703) 746-7240 (for informal or draft communications, or Customer Service Center, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

AL/m
Jan. 6th, 2003.


HOSAIN T. ALAM
PRIMARY EXAMINER